

Keith E. Sharkin
KING & SPALDING LLP
1185 Avenue of the Americas
New York, New York 10036
Telephone: (212) 556-2100
Facsimile: (212) 556-2222

Attorney for Defendant and Counterclaim Plaintiff

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

MULTI-VET LTD.,)	
)	
)	
Plaintiff/Counterclaim Defendant,)	CIVIL ACTION NO. 08-cv-03251 (LMM)
)	JURY DEMANDED
v.)	
)	
PREMIER PET PRODUCTS, INC.,)	
)	
)	
Defendant/Counterclaim Plaintiff.)	

PREMIER PET PRODUCTS, INC.'S ANSWER AND COUNTERCLAIMS

Defendant Premier Pet Products, Inc. (hereinafter "Premier") hereby answers Plaintiff

Multi-Vet Ltd.'s (hereinafter "Multi-Vet") Complaint as follows:

1. Premier is without sufficient knowledge to admit or deny the allegations of Paragraph 1, and therefore denies Paragraph 1.

2. The allegations contained in Paragraph 2 are denied.

3. The allegations contained in Paragraph 3 are admitted.

4. The allegations contained in Paragraph 4 are admitted.

JURISDICTION AND VENUE

5. Premier admits that this is an action under the statutes cited in Paragraph 5 but denies the remaining allegations of Paragraph 5.

6. The allegations contained in Paragraph 6 are admitted.

7. The allegations contained in Paragraph 7 are denied.

8. The allegations contained in Paragraph 8 are denied.

FACTS COMMON TO ALL CAUSES OF ACTION

9. The allegations contained in Paragraph 9 are denied.

10. The allegations contained in Paragraph 10 are denied.

11. The allegations contained in Paragraph 11 are denied.

12. The allegations contained in Paragraph 12 are admitted.

13. Premier admits that the mark that is the subject of U.S. Trademark Registration No. 2,762,487 is valid, but denies that Multi-Vet owns the registration.

14. The allegations contained in Paragraph 14 are denied.

15. The allegations contained in Paragraph 15 are denied.

16. Premier admits that it sells dog training collars, and except as so admitted, denies the remaining allegations of Paragraph 16.

**FIRST CLAIM SEEKING
INJUNCTIVE RELIEF FOR
TRADEMARK INFRINGEMENT (15 U.S.C. §1114)**

17. Premier repeats its responses to the allegations in Paragraphs 1 through 16 above.

18. The allegations contained in Paragraph 18 are denied.

19. The allegations contained in Paragraph 19 are denied.

20. The allegations contained in Paragraph 20 are denied.

21. The allegations contained in Paragraph 21 are denied.

22. The allegations contained in Paragraph 22 are denied.

**SECOND CLAIM SEEKING INJUNCTIVE
AND MONETARY RELIEF FOR FALSE DESIGNATION OF
ORIGIN IN VIOLATION OF 15 U.S.C. §1125(a)**

- 23. Premier repeats its responses to the allegations in Paragraphs 1 through 22 above.
- 24. The allegations contained in Paragraph 24 are denied.
- 25. The allegations contained in Paragraph 25 are denied.
- 26. The allegations contained in Paragraph 26 are denied.
- 27. The allegations contained in Paragraph 27 are denied.

**THIRD CLAIM SEEKING
INJUNCTIVE AND MONETARY RELIEF FOR UNFAIR
COMPETITION IN VIOLATION OF THE COMMON LAW**

- 28. Premier repeats its responses to the allegations in Paragraphs 1 through 27 above.
- 29. The allegations contained in Paragraph 29 are denied.
- 30. The allegations contained in Paragraph 30 are denied.
- 31. The allegations contained in Paragraph 31 are denied.
- 32. The allegations contained in Paragraph 32 are denied.
- 33. The allegations contained in Paragraph 33 are denied.
- 34. The allegations contained in Paragraph 34 are denied.
- 35. The allegations contained in Paragraph 35 are denied.

AFFIRMATIVE DEFENSES

- 36. Without admitting any of the allegations of the Complaint, Premier alleges as

follows:

FIRST AFFIRMATIVE DEFENSE

- 37. Defendant, not Plaintiff, owns U.S. Trademark Registration No. 2,762,487.

SECOND AFFIRMATIVE DEFENSE

38. Plaintiff has failed to state a claim upon which relief may be granted.

THIRD AFFIRMATIVE DEFENSE

40. Plaintiff's claims are barred under the doctrines of laches, estoppel, abandonment, waiver and acquiescence.

FOURTH AFFIRMATIVE DEFENSE

41. Plaintiff has not suffered any damages as a result of the alleged acts. Plaintiff would be unjustly enriched if allowed to recover all or any part of the damages or remedies alleged in the Complaint.

COUNTERCLAIMS

For its counterclaims against Counterclaim Defendant Multi-Vet Ltd., ("Multi-Vet"), Counterclaim Plaintiff Premier Pet Products, LLC ("Premier") demands a trial by jury and alleges upon knowledge as to its own acts and upon information and belief as to acts of others that:

THE PARTIES

1. Premier is a Virginia corporation with a principal place of business at 14201 Sommerville Ct., Midlothian, VA 23113-6884.
2. Multi-Vet is a Canadian limited liability company with an office at 17420 rue Centrale, Saint-Hyacinthe, Quebec, Canada J2T 3L7.

JURISDICTION AND VENUE

3. This is an action for trademark infringement under the Lanham Act, 15 U.S.C. § 1051 *et. seq.* This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338.

4. This Court has personal jurisdiction over Multi-Vet in that, *inter alia*, Multi-Vet voluntarily filed a Complaint in this Court to which these Counterclaims are directed.

5. Venue only may be proper in this district because the Counterclaims relate to the Complaint already pending in this district.

FACTUAL ALLEGATIONS

6. Pursuant to a Technology License and Distribution Agreement dated April 30, 2001, Premier sold dog training collars that incorporated the technology subject of Multi-Vet's U.S. Patent No. 4,627,385 in the United States.

7. Pursuant to that Technology License and Distribution Agreement, Multi-Vet would register on Premier's behalf any new trademarks adopted by Premier for Premier's use and sale of those dog training collars in the United States.

8. Under that Technology License and Distribution Agreement, any U.S. trademark registration that Multi-Vet registered based on Premier's creation and use would be assigned to Premier upon termination of the parties' relationship.

9. The GENTLE SPRAY mark was adopted by Premier after the April 30, 2001 Agreement for Premier's use and sale of dog training collars that incorporated technology subject of Multi-Vet's U.S. Patent No. 4,627,385.

10. On Premier's behalf, and based on Premier's use and development of the mark, Multi-Vet filed and obtained U.S. Trademark Registration No. 2,762,487.

11. When the parties' relationship ended on or around July of 2007, the assignment of U.S. Trademark Registration No. 2,762,487 was never executed or recorded with the United States Patent and Trademark Office.

12. Multi-Vet thereafter started use of the GENTLE SPRAY trademark on or around May 2008 when it began advertising, promoting and selling dog collars under the GENTLE SPRAY name and in packaging confusingly similar to that of Premier's in the United States.

13. An example of Premier's packaging and use of the GENTLE SPRAY mark appears on Exhibit A. The Multi-Vet packaging and use of the GENTLE SPRAY mark, as recently created and used in the United States as of May 2008, appears on Exhibit B.

COUNT I
INFRINGEMENT OF FEDERAL TRADEMARK REGISTRATION NO. 2,762,487

14. Premier hereby realleges and incorporates by reference the allegations of Paragraphs 1-13 of this Counterclaim as if fully set forth herein.

15. Premier is the lawful owner of U.S. Trademark Registration No. 2,762,487 for the mark GENTLE SPRAY.

16. Multi-Vet's use of the GENTLE SPRAY mark in connection with sales and advertising of dog collars in interstate commerce is unauthorized and without permission.

17. Multi-Vet's use of the GENTLE SPRAY mark is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1114(a).

COUNT II
FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. 1125(A)

18. Premier hereby realleges and incorporates by reference the allegations of paragraphs 1-17 of this Counterclaim as if fully set forth herein.

19. Multi-Vet has used the designation GENTLE SPRAY in connection with sales and advertising of dog collars in interstate commerce, without permission.

20. Multi-Vet's use of the designation GENTLE SPRAY is likely to cause confusion and to cause mistake, and to deceive as to the affiliation, connection or association of Multi-Vet's products with Premier and as to the origin, sponsorship, or approval of Multi-Vet's products and commercial activities by Premier.

21. Multi-Vet's wrongful activities have caused, and will continue to cause, harm to Premier.

COUNT III
COMMON LAW UNFAIR COMPETITION AND TRADEMARK INFRINGEMENT

22. Premier hereby realleges and incorporates by reference the allegations of paragraphs 1-21 of this Counterclaim as if fully set forth herein.

23. Multi-Vet's activities as stated herein constitute unfair competition and trademark infringement in violation of Premier's common law rights within the State of New York and in violation of New York law.

24. Multi-Vet's wrongful and infringing activities have caused, and will continue to cause, harm to Premier if not enjoined.

25. Multi-Vet's acts were taken in deliberate, willful and intentional disregard of Premier's rights.

PRAYER FOR RELIEF

WHEREFORE, Premier prays that the Court enter an Order:

A. For Judgment in Premier's favor on its claims of trademark infringement, false designation of origin and unfair competition.

B. For Judgment dismissing Multi-Vet's claims with prejudice.

C. Permanently enjoining Multi-Vet, its agents, servants, employees, successors and assigns and all others in concert and privity with them from using the GENTLE SPRAY mark in connection with pet products, particularly dog training collars.

D. Compelling Multi-Vet to execute the assignment for the GENTLE SPRAY mark to Premier, or, pursuant to 15 U.S.C. § 1119, directing the Director of the United States Patent and Trademark Office to correct the record for U.S. Trademark Registration No. 2,762,487 to list Premier as the Registrant of U.S. Trademark Registration No. 2,762,487.

E. Awarding all damages and items recoverable under 15 U.S.C. § 1117, including (i) Multi-Vet's profits from use of the GENTLE SPRAY mark; (ii) Premier's damages; (iii) Premier's attorneys fees and costs; and (iv) treble damages.

F. Awarding any such further relief as this Court deems just and equitable.

KING & SPALDING LLP

DATE: May 28, 2008

By: 

Keith E. Sharkin

1185 Avenue of the Americas

New York, New York 10036

Telephone: (212) 556-2100

Facsimile: (212) 556-2222

ksharkin@kslaw.com

Of Counsel:

Christopher J. Sorenson

Kristine M. Boylan

Elizabeth A. Zidones

MERCHANT & GOULD P.C.

80 South Eighth Street, Suite 3200

Minneapolis, Minnesota 55402-2215

Telephone: (612) 332-5300

Facsimile: (612) 332-9081

Attorneys for Premier Pet Products, Inc.


[Home](#) | [Pet Supplies](#) | [Help Center](#) | [Health Topics](#) | [Shipping](#) | [Privacy Policy](#) | [Contact Us](#)


Product Search

1 (800) 889-9

Flea and Tick

- Advantage Flea Control for Dogs
- Advantage Flea Control for Cats
- Frontline Top Spot For Dogs
- Frontline Top Spot For Cats
- Frontline PLUS for Dogs
- Frontline PLUS for Cats
- Program Flea Control for Dogs
- Program Flea Control for Cats
- K9 ADVANTIX

Nutrition

- Nutritional Supplements
- Arthritis and Joint Supplements

Pet Care Products

- Shampoos and Sprays
- Ear & Eye Products
- Flea and Tick Collars

Pet Medications

- Dental Products
- Dewormers

Pet Supplies

- Topicals
- Toys and Treats
- Vaccines
- Reptile Products
- Horses and Other Pets
- Pet Supplies



[Home](#) > [Traveling with your Pet](#) > [Toys for Dogs](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [Premier Pet](#)
[Home](#) > [Pet Gift Ideas](#) > [Toys and Treats](#) > [Toys for Dogs](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [Premier Pet](#)
[Home](#) > [Traveling with your Pet](#) > [Toys for Cats](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [Premier Pet](#)

Gentle Spray VALUE PACK


[View Larger](#)

Item #: PREMGSCKIT

Item Rating: [Rate this item](#)

Regular Price: \$120.00

Sale Price: **\$89.99**Enter Quantity:
[Send To A Friend](#)
[Description](#)
[Customer Reviews](#)


SHIPS GROUND. Please allow 4 to 7 business days for delivery to arrive.

The GentleSpray Value kit comes with the GentleSpray anti-bark collar which humanly teaches your dog not to bark and comes with everything you need to get started. This kit also comes with an additional 2 pack replacement batteries and 3 oz citronella refill bottles.

[See all GentleSpray products](#)

This item is DISCONTINUED. We apologize for any inconvenience.
[Gentle Spray Value Pack](#) to stop problem barking of your dog.

[Home](#) | [About Us](#) | [Help Center](#) | [Search](#) | [Order Tracking](#) | [Shopping Cart](#) | [Site Map](#)
[Policy](#) | [Pet Supplies](#) | [Pet Grooming](#) | [Frontline Plus](#) | [Healthy Pet Topics](#) | [Allergies](#)
[Heartgard](#) | [Pet Toys & Treats](#) | [K9 Advantix](#) | [Site Map](#)

Copyright © 2001 - 2008 HealthyPets.com - All rights reserved.

Exhibit A


[Home](#) | [Pet Supplies](#) | [Help Center](#) | [Health Topics](#) | [Shipping](#) | [Privacy Policy](#) | [L](#)


Product Sea

1 (800) 889-9

Flea and Tick

- Advantage Flea Control for Dogs
- Advantage Flea Control for Cats
- Frontline Top Spot For Dogs
- Frontline Top Spot For Cats
- Frontline PLUS for Dogs
- Frontline PLUS for Cats
- Program Flea Control for Dogs
- Program Flea Control for Cats
- K9 ADVANTIX

Nutrition

- Nutritional Supplements
- Arthritis and Joint Supplements

Pet Care Products

- Shampoos and Sprays
- Ear & Eye Products
- Flea and Tick Collars

Pet Medications

- Dental Products
- Dewormers

Pet Supplies

- Topicals
- Toys and Treats
- Vaccines
- Reptile Products
- Horses and Other Pets
- Pet Supplies



[Home](#) > [Traveling with your Pet](#) > [Toys for Dogs](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [MULTIVET](#)
[Home](#) > [Pet Gift Ideas](#) > [Toys and Treats](#) > [Toys for Dogs](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [ML](#)
[Home](#) > [Traveling with your Pet](#) > [Toys for Cats](#) > [Pet Supplies](#) > [Pet Supplies by Brand](#) > [MULTIVET](#)

Multivet Gentle Spray Citronella Anti-Bark Co


[View Larger](#)


Item #: PREMIERGSC

Item Rating: [Rate this item](#)

Regular Price: \$85.99

Sale Price: **\$49.99**Enter Quantity:
[Add To Cart](#)
[Send To A Friend](#)

Description

Customer Reviews



SHIPS GROUND. Please allow 4 to 7 days for your order to arrive.

Immediately and humanely stop problem barking. This bark collar is for any breed of dog that is at least 6 months old and weighs 6 lbs. or more.

The Multivet Gentle Spray citronella Anti-Bark Collar is the most effective and humane solution for nuisance barking. Stop the problem barking! Recommended by leading veterinarians, behaviorists, and trainers. Gentle Spray uses advanced technology to deliver a harmless burst of citronella spray that interrupts barking. **It's two times more effective than shock collars.** The spray stimulates the dog's senses - he sees it, hears it, smells it and feels it.

Includes:

Exhibit B

- anti-bark device (weighs 2.5 oz)
- citronella refill
- adjustable nylon collar
- 6-volt battery
- detailed instructions and lifetime warranty.



Customer Testimonial

We got one of these for our barker because a behaviorist advised us you can't argue barker when s/he's doing it. It works great and the dog smells terrific. Seriously, we know he will be in one of those situations where he is likely to bark, such as strange or a visit to a dog-friendly beach. The darn things are super-expensive, BUT **A)** they collar and **B)** they never fail, unlike dog whistles which are only useful on some dogs while your dog is sitting on your lap wearing the collar, or you will get a dose, too.

E.Z.

[Save even more, buy the value pack](#)

Customers Who Bought This Item Also Bought

		NEW! Aids
Multivet Spray Commander Remote Trainer	Premier Gentle Leader Calming Cap	Price: \$
Price: \$175.99	Price: \$19.95	Sale Price
Sale Price: \$116.99	Sale Price: \$15.99	

[Home](#) | [About Us](#) | [Help Center](#) | [Search](#) | [Order Tracking](#) | [Shopping Cart](#) | [Site Map](#)
[Policy](#) | [Pet Supplies](#) | [Pet Grooming](#) | [Frontline Plus](#) | [Healthy Pet Topics](#) | [Heartgard](#) | [Pet Toys & Treats](#) | [K9 Advantix](#) | [Site Map](#)

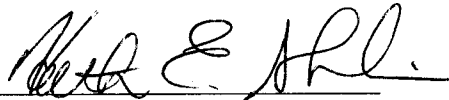
Copyright © 2001 - 2008 HealthyPets.com - All rights reserved

CERTIFICATE OF SERVICE

It is hereby certified that true and correct copies of *Premier Pet Products, Inc.'s Answer and Counterclaims* and *Corporate Disclosure Statement* were served this day via U.S. mail delivery, in an envelope addressed to:

Lawrence E. Abelman
Abelman, Frayne & Schwab
666 Third Avenue
New York, NY 10017

Dated: May 28, 2008


Keith E. Sharkin